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The time period for reply, if any, is set in the attached communication.

**RECORD OF ORAL HEARING**  
**UNITED STATES PATENT AND TRADEMARK OFFICE**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* HIROSHI MIKITANI, SHINNOSUKE HONJO,  
and TOMOMI HATANOU

Appeal 2010-012494  
Application 09/653,163  
Technology Center 3600

Oral Hearing Held: Wednesday, February 22, 2012

<sup>19</sup> Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH A.  
<sup>20</sup> FISCHETTI, *Administrative Patent Judges*

22 ON BEHALF OF THE APPELLANT:

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Application 09/653,163

1       *The above-entitled matter came on for hearing on Wednesday,*  
2       *February 22, 2012, commencing at 9:21 a.m., at the U.S. Patent and*  
3       *Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,*  
4       *Alexandria, Virginia, before Jon Hundley, notary public.*

5           JUDGE CRAWFORD: Good morning.

6           MR. DUTTON: Good morning.

7           JUDGE CRAWFORD: You can begin whenever you're ready.

8           MR. DUTTON: Thank you, Your Honors. May it please the court.

9       My name is Brian Dutton. I'm counsel for Sony Corporation, the appellant  
10      before this court today.

11       The following issue before this court is whether the Examiner erred in  
12      rejecting the claims presently on appeal. We believe that our appeal briefs  
13      and reply briefs show that the Examiner's findings are unsupported by  
14      substantial evidence and are erroneous as a result.

15       Throughout my remarks, I will refer to the Examiner's answer of June  
16      28, 2010. Beginning on page 6 of the Examiner's answer, the Examiner erred  
17      in rejecting Claims 1, 10, 17, and 21 under 35 USC 112, second paragraph.

18       Here, page 5 of the Examiner's answer erroneously concludes that the  
19      appellant has failed to adequately describe sufficient structure for performing  
20      the claimed functions of Claim 1, as well as Claims 10, 17, and 21, which  
21      contain similar limitations.

22       In response to that assertion, we wish to first point the court to this case  
23      In Re Aoyama, which was recently decided in August of this year, where the  
24      Federal Circuit has set out a two-step test construing means plus function  
25      claims.

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1        The citation for In Re Aoyama is 99 USPQ 2nd 136, and within that  
2 decision, the first step, according to the Aoyama test in construing means plus  
3 function claims is to define the particular function of the claim limitation.

4        Referring to Claim 1 on appeal, for example, page 14 of our reply brief  
5 identifies the functions of storing, limiting the customers stored in the storing  
6 means, uniquely allocating a reply electronic mail address, sending a first  
7 electronic mail, recognizing an application for the lottery, and notifying each  
8 one of said participants.

9        The second step in construing means plus function claims pursuant to  
10 the Aoyama test is to identify the corresponding structure for that function in  
11 the specification.

12       Page 13 of our reply brief refers to Figures 4 and 5 of the specification,  
13 which depict structures -- structure of the host 1 -- I'm sorry -- the host 122.

14       Likewise, the host 122 is also depicted within the lottery system of  
15 Figure 3.

16       In applying the two-step test set out in Aoyama, the structure of Claims  
17 1, 10, 17, and 21 is readily apparent to a skilled artisan. As a consequence,  
18 we believe that the Examiner erred in rejecting the claims under 35 USC 112,  
19 second paragraph.

20       Beginning on page 8 of the Examiner's answer, the Examiner erred in  
21 rejecting Claims 1 through 4, 6, 8 through 13, and 16 through 22 under 35  
22 U.S.C. § 103 as being unpatentable over Strandberg in view of Wendkos.

23       I'm going to refer to my remarks for the independent claims for the sake  
24 of time.

25       JUDGE FISCHETTI: Excuse me, Counsel.

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1           MR. DUTTON: Yes.

2           JUDGE FISCHETTI: I regress for a second.

3           MR. DUTTON: Yes.

4           JUDGE FISCHETTI: Do your drawings -- I'm looking at a lot of  
5     Japanese writing in them. Are there English translations of these?

6           MR. DUTTON: Yes. We will be submitting the English translations,  
7     but they are not presently in the file history.

8           JUDGE FISCHETTI: Because you're relying on them for your basis  
9     for overcoming the 112.

10          MR. DUTTON: Yes.

11          JUDGE FISCHETTI: It's a little hard for me right now.

12          MR. DUTTON: Well, by looking at -- not paying attention to the  
13     Japanese --

14          JUDGE FISCHETTI: Okay.

15          MR. DUTTON: Just paying strict attention to the handwritten portions  
16     --

17          JUDGE FISCHETTI: Okay.

18          MR. DUTTON: -- that were filed along with the application papers as  
19     originally filed --

20          JUDGE FISCHETTI: All right.

21          MR. DUTTON: -- you can see, for example, in Figure 4 that there is a  
22     host 122.

23          JUDGE FISCHETTI: Okay.

24          MR. DUTTON: Also, there are steps S-202, S-208, S-210, and so  
25     forth.

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1           JUDGE FISCHETTI: All right.

2           MR. DUTTON: Now, going to the specification where it describes the  
3 corresponding meetings and relationships with those steps, when pairing the  
4 two together, it's easy to see that you have a host and the host does certain  
5 things along that particular line.

6           JUDGE FISCHETTI: Okay. Thank you.

7           MR. DUTTON: Yes, sir.

8           The claims on appeal include uniquely allocating a reply electronic  
9 mail address to each of the specified participants.

10          JUDGE FETTING: Counsel, you really have two sets of claims, don't  
11 you, one directed towards electronic mail and others directed towards a URL  
12 of a web page?

13          MR. DUTTON: A URL?

14          JUDGE FETTING: Claim 10. Claim 10 would be using a URL of a  
15 web page rather than email, right?

16          (Pause.)

17          MR. DUTTON: Yes, that's correct.

18          JUDGE FETTING: So, it just seems as though you have two sets of  
19 claims, and so, I appreciate the distinction of how you're distinguishing of the  
20 art in each of those cases.

21          MR. DUTTON: Okay. Thank you. We will definitely address that.

22          I guess regarding the electronic mail in this particular instance, as we've  
23 noted in our briefs, the Wendkos reference is silent as to the presence of  
24 electronic mail. Instead, the Examiner has referred to Strandberg for this  
25 feature.

1        On pages 19 through 21 of our reply brief, we have provided the  
2        detailed analysis as to why the claimed reply electronic address is absent from  
3        within Strandberg.

4        Specifically, in Strandberg, the interested party accesses the web page  
5        in paragraph 20, and it refers back to the web page. Instead of identifying a  
6        reply electronic email address, the Examiner refers to the unique ID within  
7        Strandberg, and within that unique ID, that unique ID is not part of an email  
8        address.

9           JUDGE FETTING: The Examiner says -- well, what's the difference?  
10          So, I guess that -- so, I guess that's the question to ask you.

11          What's the difference between simply having the -- the unique ID be in  
12        the text of the email versus being part of the email address? It's just two  
13        different ways of getting to the same result, isn't it?

14          MR. DUTTON: Thank you for the question. Thank you very much.

15          Well, the answer to that -- and using the structure of the -- attaching the  
16        reply email address with the unique ID -- when you send the return email  
17        back to the host, you will send it back not -- you will send it back to a  
18        particular email address, and that email address is the email address that has  
19        been established with the message that has been sent to the participant, but in  
20        doing so, when the email address returns, it is not sent to a common email  
21        address but is sent to multiple email addresses, and depending on the email  
22        address which has been received, that will determine who the participant is  
23        and whether they're a winner and all sorts of other distinguishing factors, and  
24        so, that's one of the key differences between what the applicant is doing and  
25        what Strandberg is doing.

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1           Strandberg has more of a focus where you're sending the email, the  
2 return email goes to a common email.

3           So, our reading of Strandberg seems to be that multiple participants are  
4 sending their messages back to the same email address, whereas in our  
5 invention, multiple participants are sending the email messages back to  
6 individualized email addresses, and depending on the email address, will  
7 determine who that participant is, and so that that's the distinction that we do  
8 not see within in Strandberg.

9           The claims on appeal include sending a first electronic message to each  
10 of the participants, the reply electronic message being affixed to the electronic  
11 message, and it has its unique access key to the participants.

12          In this regard, the specification for the claims on appeal defines the  
13 participant in a lottery system as a person who -- to whom the email is sent.

14          Also, the claims include recognizing an application for the lottery from  
15 each of the participants by receiving a second email back to the reply  
16 electronic mail address, and we have noticed in our briefs Wendkos is silent  
17 as the presence of electronic mail, and to account for the deficiencies in  
18 Wendkos, the Examiner relies upon Strandberg for these features, and  
19 particularly, the Examiner contends that the purpose of allocating the unique  
20 ID in Strandberg's system is the same as that of the unique email address in  
21 the applicant's invention, and of course, we've taken exception to that  
22 characterization, noting that our claim language is specific as far as what it  
23 actually says.

24          Here, however, the Examiner has failed to identify any objective  
25 evidence that the skilled artisan would have recognized to establish an

1 equivalency between a unique ID of Strandberg and an address for an  
2 electronic mail.

3 Thus, the Examiner has erred in concluding that the combination of  
4 Strandberg and Wendkos teaches recognizing an application for lottery from  
5 each of the participants by receiving a second email back to the reply email  
6 address.

7 The claims also include notifying each one of the participants who sent  
8 back the second email address as a result of the lottery. Page 9 of the  
9 Examiner's answer is in agreement as to the absence of this feature from  
10 within Strandberg, and regarding Wendkos, a review of that reference reveals  
11 an absence to an email address.

12 Thus, again, the Examiner has erred in concluding that the combination  
13 teaches notifying one of the participants who sends back a second email  
14 address to the reply to the electronic address as a result of the lottery.

15 JUDGE FETTING: So, Counsel, if you could address the distinction in  
16 Claim 10 with the URL, as opposed to the email address --

17 MR. DUTTON: Okay.

18 JUDGE FETTING: It seems -- assuming -- just assuming arguendo  
19 that we can see a distinction in an email address and having this set that up in  
20 advance, it's not necessarily clear that putting a unique number in a URL rises  
21 to the same level of distinction as perhaps putting a unique identifier in an  
22 email address.

23 (Pause.)

24 MR. DUTTON: Okay. I guess your point is --

25 JUDGE FETTING: I believe it's similarly used in Claim 17.

1           MR. DUTTON: Here's the distinction -- well, especially in Claim 17,  
2 you will see that the URLs are different from each other, whereas within  
3 Strandberg, you're sending it back to the same URL.

4           JUDGE FETTING: Understood. But in a sense, so what? A URL is  
5 just an index. Clearly, the unique key is an index. What difference does it  
6 make, you know, whether the index is encoded in the URL or somewhere  
7 else? No matter what, you're still going to have to index into some set of data.  
8 I mean, it's just a question of where you put it. It's not clear that it arises to  
9 the level of a patentable distinction.

10          MR. DUTTON: One of the items, though, is that when you're sending  
11 your return back to distinct URLs, it does streamline the processing, as we've  
12 shown in, I guess, our Figures 3 and 4, especially, with server B, and how the  
13 process goes when you're -- when the applicant is -- when the participant is  
14 responding to the email.

15          They're sending out the -- by accessing the particular URL at this point,  
16 they can have that immediate result or immediate confirmation as to whether  
17 or not they are a winner or a loser. So, as opposed to just going into a  
18 common email situation which -- which the Strandberg does, our method --  
19 our method and apparatus provides the applicant instant notification because  
20 of the particular URL and the particular web page that is being addressed.

21          So, it just -- it helps with the processing and speed, so you're not going  
22 through a common website, and again, you have various distinctions between  
23 who the winners are and who the losers are by the particular web pages that  
24 they're accessing.

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1           So, winners are not accessing the loser URLs, and the losers are not  
2 accessing the winner URLs.

3           So, you don't -- you do not have that particular feature within -- within  
4 Strandberg. Everything is going to a common point.

5           JUDGE FETTING: Thank you.

6           MR. DUTTON: Yes.

7           JUDGE FETTING: I have no further questions.

8           MR. DUTTON: Okay. Well thank you very much. That concludes  
9 my remarks. And again, thank you for the very good questions.

10          (Whereupon, at 9:39 a.m., the proceedings were concluded.)

11